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Paper No.

SPINE MP  
LERNER, DAVID, et al.  
600 SOUTH AVENUE WEST  
WESTFIELD NJ 07090

MAILED  
SEP 08 2009  
OFFICE OF PETITIONS

In re Application of :  
Joseph P. Errico et al. :  
Application No. 10/784,598 : DECISION ON PETITION  
Filing Date: October 12, 2004 : UNDER 37 C.F.R. § 1.78(A) (3)  
Attorney Docket No.: SPINE 3.0- :  
437 :  
Title: INSTRUMENTATION FOR :  
REPOSITIONING AND EXTRACTING AN :  
ARTIFICIAL INTERVERTEBRAL DISC :  
FROM AN INTERVERTEBRAL SPACE :

This is a decision on the petition pursuant to 37 C.F.R. § 1.78(a)(3), filed January 13, 2009 to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application set forth in the Supplemental Application Data Sheet (ADS) filed concurrently with this petition.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 C.F.R. § 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 C.F.R. 1.78(a)(2)(ii). In addition, the petition under 37 C.F.R. 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and

- (3) a statement that the entire delay between the date the claim was due under 37 C.F.R. 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

37 C.F.R. § 1.78(a)(3)(iii) requires a statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of 37 C.F.R. § 1.78 and the date the claim was filed was unintentional.

Since the statement contained in this renewed petition varies slightly from the language required by 37 C.F.R.

§ 1.78(a)(3)(iii), the statement contained in this petition is being construed as the statement required by 37 C.F.R.

§ 1.78(a)(3)(iii), and Petitioner must notify the Office if this is not a correct interpretation of the statement contained in this petition.

Requirements (2) and (3) above have been satisfied. The petition does not satisfy item (1) above.

Pursuant to Rule § 1.78(a)(2)(iii), the required reference must be included in an application data sheet, or the specification must contain or be amended to contain such reference in the first sentence(s) following the title. Consequently, Petitioner has submitted a supplemental ADS with the present petition, so as to present the required reference. Petitioner has asserted that this supplemental ADS has been executed,<sup>1</sup> however this assertion is inaccurate.

**The supplemental ADS that was submitted concurrently with this petition cannot be entered, for the following two reasons:**

First, **it has not been titled "Supplemental Application Data Sheet;"** the word "supplemental" has been omitted from the title. Pursuant to 37 C.F.R. § 1.76(c)(2), "[s]upplemental application data sheets...[m]ust be titled "Supplemental Application Data Sheet."<sup>2</sup>

Second, **it has not been executed.** Petitioner will note that an ADS filed with the application is not required to be signed unless the ADS includes a nonpublication request. 37 C.F.R.

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<sup>1</sup> Petition, page 4.

<sup>2</sup> It is noted that the supplemental ADS contains the word "[s]upplemental" in the footer, instead of the title.

§ 1.33(b) requires that amendments and other papers, except for written assertions pursuant to 37 C.F.R. § 1.27(c)(2)(ii), filed in the application must be signed by an appropriate party. Therefore, an ADS or a supplemental ADS filed after the filing of an application must be signed in accordance with 37 C.F.R. § 1.33(b).

Any reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.78(a)(3)," **and should include a supplemental ADS that is both properly titled and executed.** This is not a final agency action within the meaning of 5 U.S.C § 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,<sup>3</sup> hand-delivery,<sup>4</sup> or facsimile.<sup>5</sup> Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.<sup>6</sup>

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the deciding official.

Telephone inquiries regarding *this decision* should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.<sup>7</sup> All other inquiries concerning examination procedures should be directed to the Technology Center.



Anthony Knight  
Supervisor  
Office of Petitions

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3 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

4 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

5 (571) 273-8300- please note this is a central facsimile number.

6 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

7 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.